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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,458	02/26/2004	Maximilian Arzberger	P69487US0	9322

136 7590 04/28/2006

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EXAMINER

NOVOSAD, CHRISTOPHER J

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 04/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/786,458	Applicant(s) ARZBERGER, MAXIMILIAN	
	Examiner Christopher J. Novosad	Art Unit 3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 7-13 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5 and 7-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 4 and 6 have been canceled.

Election/Restriction

Claims 1-3 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a nonelected invention. Election of the Group II invention (claims 5 and 7-13) was made without traverse in the response filed on April 11, 2006.

Accordingly, the following action on the merits of claims 5 and 7-13 to the elected invention (Group II) is set forth below.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 7-13 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention.

In independent claims 10 and 11, lines 3 and 7, respectively, the recitation “a frame having a cross-section smaller than the cross-section of the cut trench” renders the claim indefinite since the claim seeks to improperly link a positively recited element, i.e., the “frame,” to an unclaimed or merely indirectly recited element, i.e., the “cut trench.” Since the “cut

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trench” is not positively or directly recited in the claim as an element of structure, but only inferentially therein, the metes and bounds of the claim cannot be properly ascertained.

Further, in claims 10 and 11, lines 6 and 11, respectively, the recitation of “a rear area of the cut trench” is indefinite. It is not clear from the claims where the “rear area” is relative to the other recited elements of the wall cutter apparatus, nor is the “rear area” clearly set forth in the detailed description or drawings.

Dependent claims 5, 7-9, 12 and 13 are indefinite for the same reasons as their respective parent claims 10 and 11 noted above.

Further, in claim 5, lines 1 and 2, the recitation “the at least one cutting wheel” has no proper antecedent basis in the claim. In the above recitation, “wheel” apparently was meant to be --means--.

Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section of this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by the Japanese Patent Abstract No. 11200404, published 27-07-99.

In so far as the claims can be understood due to the indefiniteness noted above, The Japanese Patent Abstract ‘404 discloses an excavator (unnumbered) for making a cut trench accompanied by the formation of a free space (the space above the rotary drums 12a, 12b), the excavator comprising:

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a frame (17) having a cross-section smaller than the cross-section of the cut trench,
a supply device (unnumbered, but referred to in the Japanese Patent Abstract '404 as a "supply device") located on the frame for supplying a liquid (cement liquid which exits from the high-pressure nozzle 15 in each cutter drum) into the cut trench, and,
at least one cutting means (cutter drums 12a, 12b) located on the frame (17) for conveying soil material stripped through the free space past the frame (17) into a rear area of the cut trench and for intermixing (see last two lines of the Abstract) the soil material and the liquid (cement liquid) together in the cut trench.

With respect to claim 5, the tooth arrangement (13, 14) of the rotary drums (12a, 12b) of the Japanese Patent Abstract '404 would allow for reversing rotary movement of the drums.

Claims 5 and 10 are further rejected under 35 U.S.C. 102(b) as being anticipated by the German reference (1,634,262).

In so far as can be understood due to the indefiniteness noted above, the Figure of the German reference '262 discloses a trench wall cutter for making a cut trench accompanied by the formation of a free space (the space above the rotary cutters 6, 7), the trench wall cutter comprising:

a frame (5) having a cross-section smaller than the cross-section of the cut trench,
a supply device located on the frame (5) for supplying a liquid (within sucking tube 1 there are provided two hydraulic lines 2, 3 for supplying hydraulic fluid to the drives of the cutting wheels 6, 7) into the cut trench, and,

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at least one cutting means (cutting wheels 6, 7) located on the frame (5) for conveying soil material stripped through the free space past the frame (5) into a rear area of the cut trench and for intermixing the soil material and the liquid together in the cut trench.

With respect to claim 5, the tooth arrangement (11) of the rotary cutting wheels (6, 7) of the German reference '262 would allow for reversing rotary movement of the cutting wheels (6, 7).

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the German reference (1,634,262) in view of Cervia (U.S.P. 4,696,607).

With respect to parent claim 11, the German reference '262 is applied here as in the rejection claim 10 above. However, while the trench wall cutting apparatus of the German reference '262 is suspended on cables, the reference fails to disclose the conventional trenching apparatus features of (1) the trench wall cutter being located in substantially vertically displaceable manner on a carrier implement and (2) "a linear guidance mechanism for displaceably guiding the trench wall cutter on the carrier implement," as called for in parent claim 11.

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The latter two conventional trenching apparatus features, however, are clearly disclosed in the trenching apparatus of Cervia '607 (Figure 3 and col. 5, lines 36-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the trench wall cutter of the German reference '262 with the above-noted conventional features, noted above as (1) and (2), of the trenching apparatus of Cervia '607 for the purpose of displaceably guiding the cable-suspended trench wall cutter of the German reference on a carrier implement for carrying out the trenching operation.

With respect to claim 7, note the use of a guide rod or kelly boom 30, in the Cervia '607 apparatus, on which the cutter is mounted.

Regarding claim 8, note the kelly guide 31 in Fig. 3 of Cervia '607.

With respect to claims 9 and 13, Cervia '607 (Fig. 3 and col. 5, lines 44-46) discloses the use of a servomechanism which is a cable-hauled mechanism.

Regarding claim 12, the kelly rod 30 of Cervia '607 is telescopic or slidable within the Kelly guide 31.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J. Novosad whose telephone number is 571-272-6993. The examiner can normally be reached on Monday-Thursday 5:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached at 571-272-6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Christopher J. Novosad
Primary Examiner
Art Unit 3641

April 15, 2006]